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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S) : Vulpitta et al.
TITLE : ANTI-TELESCOPING ADHESIVE TAPE
APPLICATION NO. : 09/711,478
FILED : November 13, 2000
EXAMINER : Jane J. Rhee
ART UNIT : 1772
ATTORNEY DOCKET NO. : MAEE 2 12957

TRANSMITTAL OF
APPEAL BRIEF UNDER 37 C.F.R. §1.192

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Respectfully submitted,

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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of : Vulpitta, et al.
For : ANTI-TELESCOPING
ADHESIVE TAPE PRODUCT
Serial No. : 09/711,478
Filed : November 13, 2000
Examiner : Jane J. Rhee
Group Art Unit : 1772
Our Docket : MAEE 212957

Assistant Commissioner for Patents
Washington, D. C. 20231

APPEAL BRIEF

Dear Sir:

This is an appeal from the decision of the examiner dated February 8, 2005 and May 4, 2005, finally rejecting claims 1-7, 9-10, and 16 in the above-captioned patent application. No claims are allowed.

1. Real Party in Interest

Henkel Consumer Adhesives, Inc. of Avon, Ohio 44011 (formerly known as Manco, Inc.) is the real party in interest as assignee of the two named inventors. Henkel Consumer Adhesives, Inc. is owned (through other entities) by Henkel KgaA of Germany.

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2. Related Appeals and Interferences

There are no related appeals or interferences.

3. Status of the Claims

The application contains claims 1-7, 9-10 and 16. All claims stand rejected. The claims on appeal are claims 1-7, 9-10 and 16. A copy of these claims appears in the Appendix of Claims on Appeal attached hereto.

4. Status of Amendments

A Proposed Amendment after Final inserting "anti-telescoping" in the preambles of claims 1, 7, and 16 (reflecting the title of the invention and application) was presented to the Examiner on April 12, 2005. The Proposed Amendment was not entered. The Examiner stated that the amendment raised new issues that would require further consideration and/or search.

5. Summary of the Invention and References

A. The Invention

The invention concerns improved adhesive tape products. The adhesive tape products involved are household and stationery products such as transparent adhesive tape familiar to most consumers and office workers (specification page 1, lines 6-17). The adhesive tape product is often a long (300 inches) narrow ($\frac{1}{2}$ to 3 inches) tape wound upon a core (specification page 1, lines 10-15).

The problem being addressed by the invention is "telescoping". A telescoped roll of tape has succeeding layers slightly offset from one another creating a conical shape for the roll. Adhesive edges of each layer are exposed. The tape roll may not operate properly on a dispenser (specification page 1, line 15 to page 2, line 3). Telescoping is more of a problem with narrow tapes wound on small diameter cores (specification page 2, lines 4-6).

Applicants address the telescoping problem in three ways. In the embodiment of Figures 1-5 applicants' position a layer of compressible foam (14) between the tape core (12) and the body of tape (16) (all figures 1 and 2). This structure is recited in claim 1 which recites these three elements and requires that the foam strip surrounds the core and that the tape surrounds the core and the foam strip. Claim 1 further recites that the length of tape comprises a leader portion fixed to the core, a foam support portion and a usable tape portion. The foam support portion is positioned after the leader portion and before the usable tape portion (as proposed by the Examiner on August 5, 2004 during a phone interview with the Attorney of Record). Claim 1 also recites a compressible foam strip fixed to the tape foam support portion. Claims 2-5 define additional structural details of the foam strip and core.

In the embodiment of Figures 6 and 8, a tape core (52) is provided with an outer surface (56) which bulges outwardly at its axial center (58) giving the core a barrel shape (see Figure 6). The tape (74) is wrapped about the barrel shaped core. (Specification page 6, lines 15-27). The barrel shaped tape core surrounded by adhesive tape in several layers is recited in independent claims 7 and 16.

Claim 6 depends on claim 1 and requires both a foam strip and a barrel shaped core.

Claims 9-10 define additional structural details of the foam strip and core.

B. The References Used To Reject Claims

Schönhorn, et al. (0430548) describes modifying a tape core in order to support a body of tape. In Schönhorn's first embodiment, the core is slit axially. The axial slit provides a gap extending from one edge to the other. In this way, the core is compressible. The body of tape is then

wound upon this compressible core. In the second embodiment, the one relied upon by the Examiner, the collapsible core is achieved by enveloping the outer surface of the core with foam. The foam is glued to the core. The foam is on the order of 1-3 millimeters thick.

The Examiner acknowledges that Schonhorn fails to disclose a tape divided into a leader portion, a foam support portion and a usable tape portion. The Examiner asserts that Schonhorn teaches that the adhesive on the core serves the equivalent function as the leader portion and the foam support portion. Schonhorn describes a foam body that may be secured to the core by means of adhesive (column 5, lines 4-6). Schonhorn does not teach the use of a tape to secure the tape and a foam strip in place wound upon the core. Schonhorn further describes the enveloping of the outer surface of a non-severed core with foam (column 4, line 56 through column 5, line 1). This passage does not describe the advantages or the structure of applying an adhesive tape leader to the tape core, attaching a foam strip to a length of the adhesive tape and then wrapping the entire adhesive tape body around the core.

Rabuse, Patent No. 2,772,774 describes a tape core constructed such that it comes into contact with the roll of tape wound upon it only along the mid portion of the width of the roll of tape, and not at the edges of the tape roll. In other words, when the core is wound with a strip of pressure sensitive adhesive tape, there is a space between the edges of the innermost wrap of tape and the marginal edge portions of the core. There is no rigid core support underlying the edges of the tape roll. (column 2, lines 13-22) the edges of the tape do not contact core edges or shoulders 4 and 5 (column 3, lines 1-3).

6. Issues

- A. Claims 1-5, 9-10, and 16 are not anticipated by Schonhorn.
- B. Claims 6 and 7 are not obvious over Schonhorn in view of Rabuse.
- C. There is no teaching to combine Schonhorn and Rabuse.

7. Grouping of Claims

Claims 1-5 stand together reciting a tape core surrounded by a tape having a leader portion fixed to the core, a foam support portion, and a usable tape portion. The foam support portion is positioned after the leader portion and before the usable tape portion.

Claims 6-7, 9-10, and 16 stand together reciting both a barrel shaped core and a foam layer.

8. Argument

- A. Claims 1-5, 9-10, and 16 are not obvious in view of Schonhorn.

The rejection is stated in the last paragraph of page 2 of the February 8, 2005 action.

Claim 1 recites a hollow cylindrical core and a length of adhesive tape wound upon that core. The length of tape comprises a leader portion fixed to the core, a foam support portion and a usable tape portion. The claim also requires a compressible foam strip fixed to the tape foam support portion. Schonhorn does not teach these structures. Rather, Schonhorn teaches a modified tape core. In Schonhorn's first embodiment, the core is slit axially. This provides a gap extending from one edge to the other. In this way, the core is collapsible. The body of tape is then wound upon this collapsible core. In the second embodiment, the one relied upon in the Office Action, the collapsible core is achieved by enveloping the outer surface of the core with foam. A foam sleeve is glued to the

core. The Schonhorn structure requires one to apply adhesive either to the outside surface of the core or the inside surface of the foam sleeve, apply the foam sleeve to the core and then apply the tape to the foam sleeve.

Applicants' structure is different. Applicants do not make the core collapsible. Applicants do not mount a sleeve of foam material on a core and then wrap a length of tape around the foam material. Rather, applicants add a layer of compressible foam to the tape which is then wound around the core. This uses the adhesive already on the tape to bind the foam in place. Applicants do not need to separately adhere the foam to the core. Applicants use a simple strip of foam rather than a sleeve. Thus, claim 1 requires a length of tape to form a leader which is attached to the core. Schonhorn has no leader. Claim 1 also requires a foam support portion to which foam is attached which is then wound around the core. Schonhorn adheres the foam to the core and thus has no tape foam support portion. The claim then requires that the tape continue to a usable tape portion wound around the core and foam completing the product.

The Final Office Action under appeal acknowledges that Schonhorn fails to disclose a tape divided into a leader portion, a foam support portion and a usable tape portion. The Office Action asserts that Schonhorn teaches that the adhesive on the core serves the equivalent function as the leader portion and the foam support portion. Applicants respectfully disagree. The passage in Schonhorn pointed to in the Office Action (column 5, lines 4-6) merely recites that the foam body may be secured to the core by means of adhesive. This teaches nothing concerning the use of a tape to secure the tape and a foam strip (not adhered to the core) in place upon the core. In applicants' invention, the foam strip is not adhered to the core. Rather, it is adhered to the portion of tape which it contacts. Thus, the Schonhorn passage does not teach applicants' claimed structure or the function

of the claimed structure, adhering the tape directly to the core with the tape holding the foam strip. If one asserts that achieving the same broad overall result in a prior art reference structure, (creating an adhesive tape product on a core) is enough to support obviousness of specific structures, very few things are patentable. A new electric switch would not be patentable under the reasoning of the Office Action. It functions to turn lights on and off, just like existing switches. This would be so regardless of electrical or mechanical innovations in the new switch. Clearly, this is not the law.

It appears that the rejection may be based upon a reading of Applicants' specification and use of these teachings to say that Schonhorn teaches structures which are equivalent. Such a basis of rejection is improper under *In re Ruff*, 256 F.2d 590, 596, 118 USPQ 340, 346 (CCPA 1958). One may not use the teachings of an application to establish equivalency of structures in a particular application. The equivalency of structures in addressing a particular problem must come from the prior art, not the application being examined.

The Office Action next points to the passage in Schonhorn starting at column 4, line 56 and finishing in column 5, line 1. That passage merely endorses the enveloping of the outer surface of a non-severed core with foam. It does not describe the advantages or the structure of using an adhesive tape leader to fix the tape to the core, using a length of the tape to support a foam strip and then wrapping the entire adhesive tape body around the core. As described above, this structure is achieved without the need to apply adhesive to the core or foam. A process step is saved. Nothing in the reference suggests this structure or that this structure would be equivalent to adhering the foam directly to the core.

The section of the Office Action asserting that Schonhorn teaches the equivalent structure to claim 1 closes with the assertion that Schonhorn teaches the equivalent function of Applicants' anti-

telescoping adhesive product. Applicants are claiming a specific structure, not a function.

It is respectfully submitted that claim 1 and claims 2-5 depending from claim 1 are allowable over Schonhorn for the reasons stated above. Additionally, claims 6-7, 9-10, and 16 all require a bulge in the outer surface of the tape core making it barrel shaped. Schonhorn does not teach such a structure. Furthermore, claim 7 recites "a first portion of said tape adhering to said core, and useable tape portion wound in several turns about said core and said foam strip". Claim 16 recites "a length of adhesive tape directly attached to said to said core and wherein said foam strip is directly attached to said length of said adhesive tape". These structures are not obvious, nor suggested, in view of Schonhorn. It is submitted that claims 6-7, 9-10, and 16 are also allowable over Schonhorn.

B. Claims 6 and 7 are not obvious over Schonhorn in view of Rabuse

The Office Action maintains a rejection of claims 6 and 7 as unpatentable over Schonhorn in view of Rabuse. The Examiner stated that Schonhorn fails to disclose that the core has an outer surface bulging outwardly near the core's axial center giving the core a barrel shape. The Examiner further states that Rabuse teaches that the core has an outer surface bulging outwardly near the core's axial center giving the core a barrel shape for the purpose of obtaining a roll of tape that is highly resistant to telescoping. This rejection is improper for several reasons. First, it is asserted and supported by factual analysis that there is no teaching in the prior art to combine Schonhorn and Rabuse under heading C (see below). Combining these references (which is improper) does not teach a tape core having a barrel shape in combination with a layer of foam to address telescoping or for any other reason. Only applicants teach this concept. Thus, claims 6 and 7 are allowable over the cited references. The rejection should be reversed.

C. There is no teaching to combine Schonhorn and Rabuse

Rabuse does teach a tape core constructed with a beveled or convex face. Rabuse recites as an object of the invention is to provide a tape core which will permit the pressures built up within the roll of tape to be relieved radially to avoid the phenomenon of telescoping, which occurs when those forces are relievable only axially of the core, as in prior commercial tape rolls wound on rigid cores (column 2, lines 7-12). To accomplish this objective, Rabuse provides a tape core so constructed that it comes into contact with the roll of tape wound upon it only along the mid portion of the width of that roll of tape, and not at the edges of the tape roll. In other words, when the core is wound with a strip of pressure sensitive adhesive tape, there is a space between the edges of the innermost wrap of tape and the marginal edge portions of the core. There is no rigid core support underlying the edges of the tape roll (column 2, lines 13-22).

In effect, the combination of references stated in the Office Action is being assembled to address the problem Applicants are addressing through structures described by Applicants. Only Applicants teach a barrel shape for a core combined with a layer of foam will address telescoping. Rabuse teaches maintaining space between the edges of the innermost wrap of tape and the marginal edge portions of the core. Applying a foam layer about the core, as taught by Schonhorn, defeats the above referenced objective and thus teaches away from Rabuse. It is to be appreciated that by applying a foam layer about the core would, in effect, fill in and/or remove the space between the edges of the innermost wrap of tape and the marginal edge portions of the core. There is nothing in either reference suggesting the combination proposed.

D. Summary of Argument

Neither of the references teaches a leader portion fixed to the core, a foam support portion and a usable tape portion with a foam strip fixed to the foam support portion. Therefore, the claims 1-7, 9-10 and 16 are not properly rejected. Rabuse teaches away from Schonhorn and as such is not properly combined with this primary reference. There are no teachings, outside of Applicant's specification, to combine these references.

It is respectfully submitted, that claims 1-7, 9-10 and 16 are not obvious over Schonhorn in view of Rabuse. Accordingly, a reversal of the Examiner's decision finally rejecting claims 1-7, 9-10, and 16 and a finding of patentability with respect to these claims is in order and is respectfully requested.

Respectfully submitted,

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9. APPENDIX

Claims on Appeal

1. An adhesive tape product comprising:
 - a hollow cylindrical core having a diameter and a width and an outer surface;
 - a length of adhesive tape having a uniform width and a length substantially greater than said width wound in several turns about said core said length of tape comprising a leader portion fixed to said core, a foam support portion and a usable tape portion;
 - said foam support portion positioned after the leader portion and before said usable tape portion; and,
 - a compressible foam strip fixed to said tape foam support portion.
2. The adhesive tape product of claim 1, wherein said foam strip is 40 mils (1 mm) thick.
3. The adhesive tape product of claim 1, wherein said foam strip surrounding said core has a total thickness of 40 mils (1 mm).
4. The adhesive tape product of claim 1, wherein said foam strip surrounds said core in a single layer and said foam strip is 40 mils (1 mm) thick.
5. The adhesive tape product of claim 1, wherein said core comprises a thin solid tubular wall.
6. The adhesive tape product of claim 1, wherein said core has an outer surface bulging outwardly near the core's axial center giving said core a barrel shape.
7. An adhesive tape product comprising:
 - a tape core having an axial width, said core being hollow with a solid outer wall, said outer wall having an outer surface which bulges outwardly at its axial center giving said core

a barrel shape;

a compressible foam strip surrounding said core; and,

a length of adhesive tape having a uniform width and a length substantially greater than said width, a first portion of said tape adhering to said core, and a useable tape portion wound in several turns about said core and said foam strip.

9. The adhesive tape product of claim 7, wherein said foam strip is 40 mils (1 mm) thick.

10. The adhesive tape product of claim 9, wherein said foam strip has a width approximately equal to said adhesive tape width and surrounds said core in a single layer.

11. An adhesive tape product comprising:
a tape core having an axial width, said core being hollow with a solid outer wall, said outer wall having an outer surface which bulges outwardly at its axial center giving said core a barrel shape;
a compressible foam strip;
a length of adhesive tape directly attached to said core and wherein said foam strip is directly attached to said length of said adhesive tape; and,
said length of adhesive tape having a uniform width and a length substantially greater than said width wound in several turns about said core.